

**Claims:** Cancel all claims of record (thus, Cancel Claims 1 -19) and substitute, in lieu thereof, claims 20 - 34. See Exhibit A, the Claim Listing, attached hereto.

## **Remarks**

The Office Action objects to issuing a patent to Applicant, at this point, mainly because the invention has been determined by the PTO as being “obvious” in light of a combination of at least 3 “prior art” patent documents. Applicant believes that the rewritten claims, along with the described differences in Applicant’s invention in comparison with the “prior art” documents (herein and in Applicant’s Affidavit), and the secondary considerations show that Applicant’s invention, as viewed as a whole, is un-obvious to one skilled in the art.

Responding to the Office Action of 8/22/2005 and the associated code section 35 U.S.C. 103 (a) objection, Applicant points to the leading case in this area, Graham v. John Deere, 383 U.S.1, 148 USPTO 459 (1966). In Graham, the following analytical steps were announced to determine the test for obviousness vs. un-obviousness:

- 1) Determine the scope & content of the prior art. In this matter, there are numerous patents that the PTO cites. At least one of which, Applicant believes should not be considered a prior art document.
- 2) Determine the novelty of the invention. In this matter, no one patent cited by the PTO depicts all the major elements of the current invention as disclosed and claimed.
- 3) Determine the level of skill of artisans in the pertinent art. The inventor, Randall Finn, has more than 20 years of experience working in the

painting industry (See Rule 132 Affidavit of Randall Finn, hereinafter “Affidavit of Randall Finn”) and is well qualified to provide an opinion in this matter.

- 4) Against this background, determine the obviousness or un-obviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole. Rockwell Int’l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir. 1998)
- 5) Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need, unexpected results and failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors *must be considered* in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir.1986) (emphasis supplied).

First, one must consider the scope and content of the prior art. One reference is to U.S. Patent No. 4,862,521 to Mann. That patent is for a “watch supporting protecting insulating device.” However, Applicant’s invention is for “an apparatus for holding a paint can employing a glove and sleeve.” It is questionable as to whether the patent to Mann should be considered as a prior art document. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992). Applying the two part test in In re Clay, first, Mann has nothing to do with holding a paint can and the painting industry, so Mann is not from the same field of endeavor. The second part of the test is whether it is reasonably pertinent to the particular

problem with which the invention attempts to solve. In this case, Mann is not designed to hold a paint can or container so as to alleviate the stress on a painter's or user's wrist. So, Mann should not be viewed as a prior art document because it is not designed to address the problems solved as part of the Applicant's invention.

However, in viewing the patents cited by the Patent Office so as to determine the scope and content of the prior art, along with the novelty of the present invention assuming for argument purposes Mann is prior art, one finds the following:

(a) U.S. Patent Number 6,000,058 to Iselin does not include a horizontal strap around the sleeve with a locking device, a swivel safety clip, a vertical strap adding support vertically to the sleeve, a pouch attached to the sleeve or a strap around the glove for tightening the glove around a user's wrist.

(b) U.S. Patent Number 4,862, 521 to Mann (assuming that it can be viewed as prior art, which Applicant believes, pursuant to In re Clay, it cannot) does not include a sleeve, a horizontal strap around the sleeve, a vertical strap in support of the sleeve, a pouch, or a strap around the glove to tighten the glove at the user's wrist. It has an elastic band at the user's wrist area around the glove but this does not operate or work like the strap at the end of the glove at the wrist area employed in Applicant's invention. (See, Affidavit of Randall Finn). Specifically, the loop and strap employed in Applicant's invention is used to tighten the glove around the user's wrist so as to alleviate the stress placed on a user's wrist while painting. The Mann elastic band at the user's wrist cannot do this. Applicant's invention holds the glove onto a user's wrist using the loop and a strap but the Mann invention, with the elastic band, is not designed to do that.

( c) U.S. Patent Number 5,833,095 to Russell does not include the glove, a swivel safety clip, a vertical strap to add support to the sleeve and a strap around the glove at the user's wrist area. The Patent Office contends that there is a vertical strap but clearly looking at Figs. 1 and 3 of Russell, this is more like a button with holes and it does not operate or work as well as Applicant's invention. (See, Affidavit of Randall Finn).

Second, one must determine the novelty of Applicant's invention. In this matter, as one can see from the above recitation of the patents, no one patent cited by the PTO depicts all the major elements of the current invention as disclosed and claimed. In fact, Randall Finn states, in part, in his Affidavit as follows:

"In viewing US Patent Number 4,862,521 to Mann, the elastic wrist band around the wrist area of the glove is not the same in my invention and does not provide the same support as the strap does in my invention. The design of the strap in the wrist area of the glove in my invention is designed to hold the user's hand inside the glove especially so that the user's hand will stay in the glove when the paint can is fairly full or full of paint. The elastic wrist band around the glove in Mann would not be able to hold a user's hand in the glove when the paint can is fairly full or full of paint. My invention is specifically designed to account for this situation; that is to keep the user's hand in the glove when the paint can is fairly full or full of paint and the invention of Mann is not designed for this situation.

In viewing U.S. Patent Number 5,833,095 to Russell the invention does not contain a vertical strap to the elastic sleeve of the Russell invention. The Russell invention has fasteners that go in holes, see Figs. 1 and 3 (like buttons in a shirt). This is not like my invention. I used a vertical strap and the vertical strap adds much more support than in the Russell invention and in my opinion, based on my over 20 years in the painting industry, and working with my invention, the vertical strap is a much more stable and secure design."

Third, one must determine the level of skill of artisans in the pertinent art. The inventor, Randall Finn, has more than 20 years of experience working in the painting industry (See Affidavit of Randall Finn) and is well qualified to provide an opinion in this matter. The prior art references must suggest to the skilled artisan that they can be

combined and that combination would have a reasonable probability of success. See, Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F. 3d 1568 (Fed.Cir. 1996). In this case, there is no suggestion in the prior art to combine these patents, and it is Applicant's opinion, based on his knowledge and skill in the industry, and that level of skill in the pertinent art, it would not lead one to combine all of these patents cited by the Patent Office. (See, Affidavit of Randall Finn). Care must be taken to avoid hindsight reconstruction by using a patent application as a guide to combine a maze of prior art references and combine them in the right way so as to achieve the result of obviousness. See, Grain Processing Corp. v. American Maize-Products Co., 840 F. 2d 902 (Fed. Cir. 1988).

Fourth, against this background, one must determine the obviousness or un-obviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole. Rockwell Int'l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir.1998). When one considers the invention as a whole, one determines that no one patent contains all the elements claimed in Applicant's invention. ***Further, none of the patents depict a vertical strap providing support to the sleeve or a strap at the glove area to tighten the glove onto a user's wrist.*** Further, one skilled in this art would not, based on Applicant's opinion, combine all of these patents to create such an invention. It was only through Applicant's efforts and skill that he invented his invention which is non-obvious to one skilled in this art. (See, Affidavit of Randall Finn).

Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need, surprise of others, unexpected results or

failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors **must be considered** in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir.1986) (emphasis supplied). The relevant evidence on the obviousness vs. non-obviousness issue, the Court, even in Graham, said, and as other courts have emphasized, it must include evidence on secondary considerations and it is error to exclude that evidence from consideration. See, Stratoflex, Inc. v. Aeroquip Corp., 713 F. 2d 1530 (1983).

In regard to the secondary considerations, Randall Finn states, in part, in his Affidavit as follows:

“I have showed my invention to many of my friends that perform painting work and they liked the invention and were **surprised by the way it worked** so well. They indicated that they **have never seen this in the painting field** and wanted to use it. When they used my invention, they indicated that they liked it and were surprised by the way it worked so well.

For this reason, namely the strong indication of others in the painting field liking the invention, the invention is going to be **a commercial success**.

The great attribute of my invention is that it reduces stress on a painter's wrist and fingers. You see, a painter, when holding a paint can filled with paint, while painting, places his or her thumb under the metal handle of the paint can and the rest of his or her fingers on the paint can itself. This causes a painter extreme pain, especially when used over an extended period of time. With my invention, a painter's thumb and fingers are protected by the glove and this helps in alleviating any pain. Further, the strap in the wrist area of the glove keeps the glove on the user's hand as he or she paints. The invention **satisfies a long felt need** in the painting industry because painters for years and years have been holding a paint can in this way (the thumb against the can and metal handle over the thumb) and my invention solves the problem that a painter experiences when he or she holds the paint can in this way. Now, with my invention, a painter will no longer have to place his or her thumb under the metal handle of the paint can but rather can use the glove to hold the paint can.

It is my opinion, based on my years of experience in the painting field and my analysis of the previous patents cited by the Patent Office, that my invention, as a whole, is **un-obvious to those skilled in this art.**” (emphasis supplied)

So that the Patent Office can view how the invention is used both before and after the invention was made. Applicant has attached Exhibit B attached hereto.

In further response to the obvious vs. un-obvious issue, in this matter, this is not a mere substitution of one element for another to come up with a new invention like in Hotchkiss v. Greenwood, 52 U.S. 248 (1850). The Applicant, with respect to his invention, developed a wholly new invention which, as a whole, is not disclosed by any one patent or group of patents cited by the PTO.

With respect to Applicant's invention, the combination he created is a new invention with such combination, as a whole, not reading on another patent. Further, unlike in Graham, Applicant's invention is not a mere modification of an existing device (where Graham merely reversed the shank and hinge plate's position to create a new invention which was held to be obvious). Applicant has provided a new product and as a whole, his invention is un-obvious to one skilled in this art.

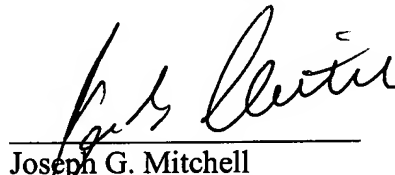
There is not one patent cited that cites all the elements listed in Applicant's disclosure and the newly written claims.

The Patent and Trademark Office has to combine, in some cases, three patents in order to try to show obviousness. The need to combine so many patents, by definition, shows un-obviousness, rather than obviousness. The more prior art documents needed to try to depict obviousness proves that the invention is un-obvious.

### **Conclusion**

For all the foregoing reasons, Applicant submits that the specification, drawings, and claims are now in proper form, and that the claims all define patentably over the prior art. Therefore, Applicant submits that his patent application is now in condition for allowance, which action he respectfully requests.

**Very Respectively,**



Joseph G. Mitchell

Title : Patent Attorney

PTO # 40,730

Address:

4521 Derby Lane

Smyrna, GA 30082

Phone : 404-943-2981

e-mail: joeymitch@earthlink.net

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